REMARKS

Claims 1-4, 7-5, 24, 25, 28-36, 45 and 46 are rejected under 35 U.S.C. § 103 as being
5   unpatentable over Canale *et al.* (USPN. 5,619,648) in view of Salimando *et al.* (USPN
6,185,599). Additionally, Claims 5, 6, 26, and 27 are rejected under 35 U.S.C. § 103 as
being unpatentable over Canale-Salimando, further in view of Cohen (USPN
5,633,910).

10   Applicant respectfully disagrees. However, in the interest of prosecuting the application
in an efficient manner, and without unnecessarily limiting the scope of coverage of the
claims or surrendering any equivalents, but merely to place the application in allowable
condition by clarifying the claim language, Applicant has amended independent Claims
1, 24, and 45 as follows:
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The advice consumer is advised of information only if said information meets certain
predetermined relevance criteria "as determined by said reader";

The advice provider "broadcasts" highly targeted advice "the relevance of which to an
20   advice consumer is determined by said reader."

Applicant has, in previous responses, addressed both Canale and Salimando.
Applicant is of the opinion that the combination is improper. However, Applicant does
not repeat its previous arguments here, but merely directs the Examiner to its previous
25   submissions and respectfully requests that the Examiner carefully review these previous
arguments and reconsider same.

Applicant's claim amendments are directed to the limitations that were added in the
Preliminary Amendment submitted with the recently filed RCE. These limitations are
30   concerned with maintaining confidentiality of the advice consumer. Applicant has
clarified that this confidentiality is maintained by a specific mechanism, that is, the

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reader receives a stream of broadcast advisory information from the advice provider. The reader applies various relevance criteria to the broadcast stream. When a particular piece of broadcast advice is matched by the reader to the relevance criteria, the advice consumer is advised of the information. That is, the advice provider is a simple

5   broadcast facility that sends out a stream of advice without any particular destination in mind. The reader monitors streams of advice and captures messages that match relevance criteria. The captured messages are then provided to the advice consumer. This mechanism is used to maintain confidentiality. In short, because the broadcaster does not know to whom the messages are being sent and who is receiving any

10   particular message, the broadcaster has no idea as to the identity of the advice consumer. The advice consumer is merely watching these advisories and selecting those that are of interest without revealing its identity. This is because the advice consumer is one of many that are monitoring a stream. What is done with this stream by the reader is not known by the advice provider, this is only known to the advice

15   consumer.

As Applicant had previously argued, Canale does not have an advice provider that broadcasts information, and Salimando is lacking in a mechanism for matching advice to a consumer. With regard to the Examiner's statements in the recent Office Action

20   concerning the fact that "the advice provider offers highly targeted advice without compromising individual privacy and without learning of identity and attributes of said advice consumer, and the environment includes data of a sensitive or private nature," the Applicant refers to those portions of Canale relied upon by the Examiner. Starting at column 6, lines 1-9, Canale teaches that the user model, which allows the mail filters of

25   Canale's invention to operate, "would be private to the user, that is not stored in a central database." There is no indication by Canale that a reader would be used to match relevance criteria to a broadcast stream. As the Examiner admits "Canale does not specifically disclose the advice provider broadcasts information." Thus, the person skilled in the art, considering Canale's statement that the email filter is not stored in a

30   central database, would not be taught that an advice reader would monitor a broadcast stream to maintain a user's anonymity.

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Considering now the Examiner's citation of column 7, lines 1-6, the person skilled in the art is taught that there are two database files in Canale's invention that are specific to, and owned by, an individual user of the mail filter. Canale merely notes that "we do not

5   assume that these files can be directly accessed by anyone other than the user and mail filter..." Canale, here, is not suggesting that a reader would match relevance criteria for an advice consumer to advice broadcast by an advice provider to maintain the user's anonymity. Rather, Canale here is only concerned with maintaining confidentiality with regard to the user's particular filter. Applying this knowledge to

10 Applicant's invention, Applicant has an advice reader that maintains a set of relevance criteria. The Examiner appears to be analogizing this relevance criteria to the filter in Canale. Even if this were so, the contents of the reader, that is the relevance criteria, is not useful in maintaining anonymity of the advice consumer, except in that it looks and selects documents from an advice provider. This is a different mechanism than that of

15 Canale, where an email filter is used to determine what emails a user wishes to receive. There is no notion in Canale that the mechanism of Canale is used to allow a user to receive targeted information without revealing the user's identity to the broadcaster of the targeted information. Canale allows a user to set information to be excluded, not to monitor a stream of information for relevant information. Thus, there is no reason to use

20 Canale in a broadcast model.

Finally, considering the Examiner's citation at column 10, lines 25-33, Canale states:

"Such a system naturally raises many privacy issues that can be addressed. For

25   example, you may not necessarily let the person seeking the recommendation know who gets the request-for-advise message. That way, people would not feel obliged to respond. Also, the identity of the requester could be protected by simply having a message saying "A friend would like an opinion or recommendation about service Y." In that case the EYPS would only reveal the

30   identity of the requester once the recipient agrees to respond."

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None of these mechanisms are similar in any way to that set forth in the claimed invention. Here, Canale indicates that there is a mechanism for maintaining privacy in a proactive mail filtering implementation of Canale's invention. The Examiner is directed to column 10, lines 14-24, which places the Examiner's cited paragraph into context.

5 The mechanism cited by Canale provides a mail header that is interpreted by the mail filter. This is just a natural extension of the Canale invention and has nothing to do with the anonymous reception of targeted advice. Canale's discussion of privacy here has to do with specific requests for advice. Thus, Canale is teaching an introduction system that allows requests for introduction to be screened. Hence, the system does not

10 necessarily want the person seeking a recommendation to know who gets the request; nor would the person getting the request want to feel obligated to respond to the request. This protects the person receiving the request. Canale also indicates that the requester can be protected by putting a header indicating that a friend requests the information. Both of these mechanisms are concerned with an introduction system,

15 maintaining the anonymity of the person receiving the request and the person sending the request. This has nothing to do with the broadcasting of targeted advice and the interception of a stream of broadcast targeted advice by a reader, by matching relevance criteria, so that an advice consumer can receive only that information desired, without revealing their identity.

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One way to think of the invention is to think of a subscription. When one subscribes to a particular publication, one must have an address to which the information is sent. Thus, the publisher knows to whom the information is being sent. The invention makes it possible for an advice provider, *i.e.* the publisher, to send out information which may be

25 of a private nature (see Claim 6 for example), and for an advice consumer to subscribe to this information without identifying himself to the advice provider. This is much different than Canale's mail filtering system, which does not deal with a broadcast model.

30 The addition of Salimando, as noted in Applicant's previous arguments, adds nothing to this combination.

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Applicant is of the opinion that the Examiner has failed to make a *prima-facie* case of obviousness. A *prima-facie* case of obviousness requires that the following criteria be met:

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1. There must be motivation to combine the cited documents to produce the claimed invention. Here, there is no motivation in Canale to adopt an email filter to an advice broadcast, advice system, as taught by the claimed invention. Further, there is no motivation to add Salimando's communication circulation system to an email filter to

10 produce the claimed invention.

2. A *prima-facie* case of obviousness must indicate that there is a likelihood of success that the proposed combination can be made. Here, there is no way that one skilled in the art would know how to take Salimando's data tagging and data scanning

15 system and add it to an email filter as taught by Canale. The only way that the two references could be combined to produce the claimed invention is if they were significantly both modified, which modification would require inventive effort.

3. The cited references must teach each and every element of the claimed

20 invention. Here, there is substantial lacking in teaching. In particular, nowhere in the references cited is there an advice provider that broadcasts information to target situations based on arbitrary combination of verifiable conditions of an advice consumer. The Examiner has previously taken issue with this position but Applicant is of the opinion that it is correct.

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Further, there is no provision of a reader that determines if broadcast information meets predetermined relevance criteria. There is no mechanism provided in either reference that interprets broadcast information for relevance. Canale's email filter is not concerned with the broadcast of targeted information. Additionally, there is no mechanism for

30 maintaining anonymity of an advice consumer in an advice provider system, such as that claimed, where the advice provider broadcasts information to an advice consumer.

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Because there is serious doubt with regard to the *prima-facie* showing of obviousness, these doubts should be resolved in favor of the patentability of the claimed invention. Applicant, therefore, earnestly solicits the Examiner's reconsideration of the pending
5 claims in the application, especially in view of the Applicant's amendments to the independent claims, which have clarified the mechanism by which anonymity is maintained and which clearly contrasts with those schemes cited by the Examiner in Canale.

10 Applicant notes also that the dependent claims, while deemed allowable because of their dependency on what an applicant considers to be allowable base claims, are nonetheless entitled to patentability in their own right. Nowhere in either of the references is taught or suggested those elements set forth in the dependent claims. For example, the references do not teach the use of relevance criteria as set forth in Claims
15 2-6. The references do not teach the notion of an inspector library, as taught in Claims 7-15. Likewise, Applicant maintains that the other dependent claims, which are of similar scope, are not taught or suggested by the cited references.

For example, with regard to Claim 2, the Examiner refers to Canale at column 5, lines
20 65 to column 6, line 26. Here, Canale gives the Example of a model of a person's areas of interest. A person's area of interest is not the same thing as relevance criteria comprising:

"a set of any demographic, biologic, geographical, and other empirical models
25 used to infer statistically that a certain condition is highly likely to be true, even when it cannot be verified by direct calculation, measurement, or formal logical deduction, by using any of information which may be publicly available, information present in the user profile, information directly measurable, or information available to third parties."

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Canale simply does not teach anything of the sort, the Examiner's comments notwithstanding. The same is true with regard to the Examiner's citation to Salimando at column 4, lines 20-59.

5 Rather than address each of these issues raised by the Examiner, the Applicant asks the Examiner to review these citations with regard to the dependent claims. It would appear that the Examiner should have indicated allowable subject matter for at least some of these claims. Accordingly, a more careful review is deemed appropriate.

10 In view of the foregoing, and Applicant's amendment to the claims, the application is deemed to be in allowable condition and the Examiner is respectfully requested to withdraw all objections and issue a Notice of Allowance. Should the Examiner deem it helpful, he is encouraged to contact Applicant's attorney, Michael A. Glenn, at (650) 474-8400.

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Respectfully submitted,

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